

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Kuriacose Joseph et al. Examiner: Yogesh Garg
Serial No.: 09/903,457 Group Art Unit: 3625
Filed: July 10, 2001 Docket No.: 2050.001US6
Customer No.: 44367 Confirmation No.: 9752
Title: APPARATUS FOR TRANSMITTING AND RECEIVING EXECUTABLE APPLICATIONS AS FOR A MULTIMEDIA SYSTEM, AND METHOD AND SYSTEM TO ORDER AN ITEM USING A DISTRIBUTED COMPUTING SYSTEM

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Applicants respectfully request review of the rejections of claims specified below in the Final Office Action of June 29, 2009 as: (1) being based on a defective reissue declaration; (2) as being barred under § 251 under the recapture doctrine, and (3) as being obvious under 35 U.S.C. § 103(a). No amendments are submitted with this request. Claims 168-184, 221-235, 247, and 250 are previously withdrawn. Claims 1-164, 186-217, 237-246, 248-249, 251, and 253-255 are previously cancelled. Claims 165-167, 185, 218-220, 236, 252, and 256-261 are currently pending. This request is being filed with a Notice of Appeal. The review is requested for the reasons articulated below.

Substitute Oath/Declaration

The Examiner rejected claims 165-167, 185, 218-220, 236, 252, and 256-261 as being based upon a defective reissue declaration filed on July 10, 2001 under 35 U.S.C. § 251, on the basis that the reissue declaration does not identify the existence of an error, which error causes the original patent to be defective.¹ However, as occurred within a co-pending divisional reissue application of the same original patent, the Office Action ignores a substitute reissue declaration filed with the previous response on May 12, 2009. This substitute reissue declaration is believed to have cured any basis for this rejection. Specifically, this substitute reissue declaration states as follows:

I believe original U.S. patent no. 5,819,034 to be wholly or partly inoperative by reason of my claiming less than I had the right to claim in the patent. Specifically, the patent discloses a method and system that, stated generally, uses a client system

¹ Final Office Action of June 29, 2009, page 6.

to facilitate the determining of an item identity for an item to which an order request pertains, automatically retrieving personal information previously stored in a permanent memory in the client system, and causing an order to be placed, where the order including the item identity and the retrieved personal information. This invention is distinct from the invention claimed in the original patent; and is not claimed in the patent. This error is addressed in this reissue by including claims directed to methods of, and systems for, facilitating ordering an item, where the order includes the item identity and the retrieved previously stored personal information. In particular, the error is addressed by the presentation of claims 165, 218, 252, 260, and their respective dependent claims, drawn to this previously unclaimed invention.

Thus, the substitute reissue declaration clearly identifies the error in the original claims, that such claims do not address the different invention covered by the newly-submitted claims. Applicants respectfully request that the declaration submitted May 12, 2009 be considered, and that the rejection be reversed.

§ 251 Rejection of the Claims

Claims 165-167, 185, 218-220, 236, 252, and 256-261 were rejected under 35 U.S.C. § 251 as "being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based."² In the current Final Office Action, the Examiner states that these claims were rejected under 35 U.S.C. § 251 because they are broader than the patented claims 1-9, because they do not include limitations recited in the patented claims 1-9, and therefore allegedly are barred by the recapture rule. It appears that this position is founded on a misunderstanding of the prohibition against recapture. The Office Action makes clear that the entire basis for this rejection is that the originally-issued claims are not present in this divisional application;³ and is express that but for those original claims not being present in this reissue application, no recapture would be considered to exist: [interpreting "MPEP 1412.02 C" to state that] "overlooked aspects can be claimed in a reissue application but the claims that were amended and narrowed to obtain patent in the original application cannot be deleted."⁴

However, no rule that the original claims be present is imposed by either 35 U.S.C. § 251 or

² Final Office Action of June 29, 2009, page 8.

³ Final Office Action of June 29, 2009, pages 3-5; "claims claiming additional inventions or embodiments not originally claimed are permissible only if any claims amended during prosecution of the original application to obtain the patent are not deleted or broadened by reissue;" and "since the applicant has canceled all of the patented claims which were amended during prosecution of the original application to obtain the patent it is impermissible recapture."

⁴ *Id.*

MPEP § 1412.02. The absence or presence of the original claims in a reissue application has no bearing on whether claims for a different invention may be submitted (as is done here), and the presence, or absence, of such original claims is not a touchstone test for recapture as the Office Action asserts. Rather, the pertinent test is whether the claims submitted in the reissue application are for a different invention than that addressed by the originally issued claims.

The recapture rule and the scenarios under which the recapture rule bars reissue claims are addressed in MPEP 1412.02 titled "Recapture of Canceled Subject Matter." In pertinent part, MPEP 1412.02 states that *if the reissue claims are claiming additional inventions or embodiments not originally claimed, then recapture is not present . . .*⁵ As noted above, in the present reissue application, the new claims are directed to methods and systems of facilitating ordering an item, where the order includes the item identity and the retrieved previously stored personal information, and thus are related to a different invention than the invention claimed in the original patent (e.g., a system configured to receive and execute a distributed computing application that alters an associated video program).

Space constraints here do not permit a complete addressing of the possible bases for the misconception stated in the Office Action. But MPEP § 1412.02 (I)(C) is clear in identifying a recapture analysis process, but providing expressly that notwithstanding that recapture analysis, there is an express exception for claims directed to additional inventions/embodiments not originally claimed:

If, however, the reissue claim(s) are really claiming additional inventions/embodiments/species not originally claimed (i.e., overlooked aspects of the disclosed invention), then recapture will not be present.⁶

If the position espoused in the Office Action were correct, then a patentee would never be able to file multiple divisional applications from a reissue application to address different newly-claimed inventions. Yet such divisional applications are clearly permitted. In fact, the originally-issued claims of the patent under reissue here are found within such a divisional reissue application, serial number 09/903,458, filed July 10, 2001. If those same original claims were also present in this

⁵ MPEP 1412.02 (I)(C). ("If, however, the reissue claim(s) are really claiming additional inventions/embodiments/species not originally claimed (i.e., overlooked aspects of the disclosed invention), then recapture will not be present.")

⁶ MPEP 1412.02 (I)(C).

divisional application, they would clearly be subject to rejection based on statutory (\$ 101-type) double patenting.

As expressly stated in the MPEP in addressing tests for impermissible recapture, where, as here, reissue claims are claiming an additional invention not originally claimed, recapture is not present. Applicants therefore respectfully submit that under 35 USC § 251 and the guidance of the MPEP, recapture is not present in the present application; and Applicants request that the rejection be reconsidered and reversed.

§ 103 Rejection of the Claims

In the Final Office Action of June 29, 2009, the Examiner reiterated the rejection of claims 165-167, 185, 218-220, 236, 252, and 256-261 under 35 U.S.C. § 103(a) as being obvious over Florin et al. (U.S. Patent No. 5,621,456) in view of Garneau et al. (U.S. Patent No. 5,497,420).

Claim 165 requires "automatically retrieving personal information ... previously stored ... in the client system." The Examiner correctly observed that Florin fails to "explicitly disclose" that limitation,⁷ and cites Garneau to teach the limitation (citing col. 2, lines 25-37 of the reference). Garneau is inaccurately characterized as teaching "automatically retrieving a physical address of the subscriber terminal . . .";⁸ although the retrieved information in Garneau is actually "a unique logical or physical terminal address,"⁹ not personal information.

In Garneau, when a subscriber inputs a number corresponding to a particular program or code into a subscriber terminal, the terminal retrieves a logical or physical ID of the terminal. This ID, that may be stored in ROM, is used at the central station to determine whether the terminal is associated with a valid subscriber terminal number.¹⁰ Thus, the logical or physical ID of the terminal in Garneau is machine-specific and merely identifies a piece of hardware that may be utilized by any number of users. Thus, it is not personal information of a user.

The Office Action misquotes Garneau by characterizing the logical or physical ID of the terminal as "a physical address of the subscriber terminal" and then extrapolates from that erroneous starting point, stating that Garneau teaches "retrieving a physical address . . . previously stored to

⁷ Final Office Action of June 29, 2009, page 5.

⁸ Final Office Action of June 29, 2009, page 15.

⁹ Garneau, col. 2, lines 25-28.

¹⁰ Garneau, 2: 15-47.

enable placement of an order for a pay-per-view event" and that it would be obvious to one skilled in the art" to incorporate this feature of Gameau because it would help the [Florin] process to coordinate the billing and conclusion of the order by identifying the buyer and billing it to him the order charges.¹¹ Such extrapolation is entirely unwarranted based on the description of Garneau. Garneau therefore fails to disclose or suggest "retrieving *personal information* previously stored ... in the client system" recited in claim 165.

Thus Florin fails to disclose the identified limitation of retrieving previously stored personal information; and the Garneau reference asserted to teach that limitation, does not teach it. Thus the combination of Florin and Garneau does not disclose or suggest the recited limitation of "automatically retrieving personal information ... previously stored ... in the client system," as recited in claim 165, and thus cannot render the claim obvious.¹² Claims 218, 252, and their respective dependent claims are patentable for at least the reasons articulated above. Applicants respectfully request reconsideration and withdrawal of the rejection of the identified claims.

CONCLUSION

The applicant respectfully submits that all of the pending claims are in condition for allowance, and such action is earnestly solicited. The Examiner is invited to telephone the below-signed attorney at 408-278-4052 to discuss any questions which may remain with respect to the present application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,
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¹¹ Final Office Action of June 29, 2009, page 15.

¹² *KSR v. Teleflex*, 82 U.S.P.Q.2d at 1395 (2007) ("A rationale to support a conclusion that a claim would have been obvious is that *all the claimed elements were known* in the prior art . . .").

Certificate of Electronic Filing

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